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Peter Van Horne

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EXAMINER

WORJLOH, JALATEE

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Please find below and/or attached an Office communication concerning this application or proceeding.

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* PETER VAN HORNE,
9 KEITH OLSON, and
10 KEVIN MILLER
11

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13 Appeal 2009-004817
14 Application 09/848,534
15 Technology Center 3600
16

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18 Decided: December 23, 2009
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22 *Before* MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU
23 R. MOHANTY, *Administrative Patent Judges*.

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25 CRAWFORD, *Administrative Patent Judge*.

26
27
28 DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection of claims 39-82. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellants invented systems and methods for remotely establishing an electronic communications link between an electronic communications network, such as the Internet or a wide area network, and a communications device, such as a portable computing device (Spec. 1:7-10).

Claim 39 under appeal is further illustrative of the claimed invention as follows:

39. A method for providing communication among a client system, a server system and an electronic communications network, the client system including a Central Processor Unit (CPU), volatile working memory associated with the CPU, and a communications interface, the client system further running client software for managing the communications between the client system and the electronic communications network, the server system running server software for managing communications between a plurality of client systems and the electronic communications network, the method comprising:

if a previous session using said client software completed unsuccessfully:

offering a user an option of either continuing or restoring system settings of said client system;

receiving from said user an indication responsive to said offering; and

determining whether to restore said system settings based at least in part on said indication;

specifying a billing preference, said billing preference chosen from a predefined set of billing options, said billing options including at least one technique for making a monetary payment;

1 transmitting said billing preference to the server system;
2 receiving a billing approve/reject signal from the server
3 system;
4 accessing the electronic communications network via the
5 server system if an approve signal is provided in said receiving;
6 and
7 conducting two-way communications with the electronic
8 communications network via the server system.

9 The prior art relied upon by the Examiner in rejecting the claims on
10 appeal is:

11	Ahmad	US 5,565,908	Oct. 15, 1996
12	Lewis	US 5,612,730	Mar. 18, 1997
13	Budow	US 5,661,517	Aug. 26, 1997

14 The Examiner rejected claims 58-76 under 35 U.S.C. § 112, second
15 paragraph, for indefiniteness; rejected claims 39-57 and 65-82 under 35
16 U.S.C. § 103(a) as being unpatentable over Budow in view of Lewis; and
17 rejected claims 58-64 under 35 U.S.C. § 103(a) as being unpatentable over
18 Budow in view of Ahmad and Lewis.

19 We AFFIRM-IN-PART.

20
21 ISSUES

22 Did the Appellants show the Examiner erred in asserting that the
23 functional limitations of independent claims 58, 65, and 74 are indefinite?

24 Did the Appellants show the Examiner erred in asserting that a
25 combination of Lewis and Budow renders obvious the subject matter of
26 independent claims 39, 46, and 55, because the “if” clauses were not
27 considered and thus the Examiner did not establish a proper case of prima
28 facie obviousness?

1 Did the Appellants show the Examiner erred in asserting that a
2 combination of Lewis, Ahmad, and Budow renders obvious the subject
3 matter of independent claims 58, 65, 74, and 77-82, because the “if” clauses
4 were not considered and thus the Examiner did not establish a proper case of
5 prima facie obviousness?

7 FINDINGS OF FACT

8 *Specification*

9 Appellants invented systems and methods for remotely establishing an
10 electronic communications link between an electronic communications
11 network, such as the Internet or a wide area network, and a communications
12 device, such as a portable computing device (Spec. 1:7-10).

14 PRINCIPLES OF LAW

15 *Claim Construction*

16 The characterization of “functional” indicates nothing more than the
17 fact that an attempt is being made to define something by what it does rather
18 than by what it is. There is nothing intrinsically wrong with the use of such
19 a technique in drafting patent claims. *In re Swinehart*, 439 F.2d 210, 212-13
20 (CCPA 1971).

21 ““Functional”” terminology may render a claim quite broad. By its
22 own literal terms a claim employing such language covers *any and all*
23 embodiments which perform the recited function. *Id.*

24 Where the Patent Office has reason to believe that a functional
25 limitation asserted to be critical for establishing novelty in the claimed
26 subject matter may, in fact, be an inherent characteristic of the prior art, it

1 possesses the authority to require the applicant to prove that the subject
2 matter shown to be in the prior art does not possess the characteristic relied
3 on. *Id.* at 212-13.

4 Additional content stated in the permissive form does not narrow the
5 scope of the claim. As a matter of linguistic precision, optional elements do
6 not narrow the claim because they can always be omitted. *In re Johnston*,
7 435 F.3d 1381, 1384 (Fed. Cir. 2006).

8 During examination of a patent application, a pending claim is given
9 the broadest reasonable construction consistent with the specification and
10 should be read in light of the specification as it would be interpreted by one
11 of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d
12 1359, 1364 (Fed. Cir. 2004).

14 ANALYSIS

15 *Functional Limitations*

16 We are persuaded of error on the part of the Examiner by Appellants'
17 argument that the functional limitations of independent claims 58, 65, and 74
18 are not indefinite (App. Br. 19-20). There is nothing intrinsically wrong
19 with defining something by what it does rather than by what it is in drafting
20 patent claims. *See In re Swinehart*, 439 F.2d at 212-13. Indeed, use of a
21 functional limitation often renders a claim quite broad, and allows the
22 Examiner to require the Appellants to prove that the subject matter shown to
23 be in the prior art does not possess the characteristic relied on. *See Id.* at
24 212-13. By using the terms "said client system being configured to:" in
25 independent claim 58, Appellants are merely claiming a client system that
26 has the structure capable of performing the recited "receive," "determining,"

1 “specify,” “transmit,” “receive,” “accessing,” and “conduct” functions. A
2 similar analysis applies to independent claims 65 and 74, which each recite a
3 “server system configured to:”.

4

5 *Independent Claims 39, 46, and 55*

6 We are not persuaded of error on the part of the Examiner by
7 Appellants’ argument that because the “if” clauses were not considered, the
8 Examiner did not establish a proper case of prima facie obviousness, a thus a
9 combination of Lewis and Budow does not render obvious the subject matter
10 of independent claims 39, 46, and 55 (App. Br. 17-19, 20-21). The “if”
11 conditional clause in these claims are optional elements because in
12 implementing the method, should the “if” condition not be met, the
13 “offering,” “receiving,” and “determining” steps would never be invoked.
14 *See In re Johnston*, 435 F.3d at 1384. During examination, claims are given
15 their broadest reasonable interpretation. *See In re Am. Acad. of Sci. Tech.*
16 *Ctr.*, 367 F.3d at 1364. As under the broadest scenario, the steps dependent
17 on the “if” conditional would not be invoked, the Examiner was not required
18 to find these limitations in the prior art in order to render the claims obvious.

19

20 *Independent Claims 58, 65, 74, and 77-82*

21 We are persuaded of error on the part of the Examiner by Appellants’
22 argument that because the “if” clauses were not considered, the Examiner
23 did not establish a proper case of prima facie obviousness of independent
24 claims 58, 65, 74, and 77-82 (App. Br. 17-19, 20-21). Unlike independent
25 claims 39, 46, and 55, which recite methods, independent claims 58, 65, and
26 74 recite system claims with a client/server system configured to carry out

1 the recited “if” conditional steps. Accordingly, even if the system never
2 *actually* performs the “if” conditional steps, the client/server systems are still
3 *configured to* and thus *capable* of performing the “if” conditional steps, and
4 must be given patentable weight. Thus, as the Examiner has not set forth a
5 prima facie case as to how the combination of Lewis, Ahmad, and Budow
6 sets forth any structure capable of performing the aforementioned “if”
7 conditional aspects, we do not sustain the rejections of these claims.

8 Independent claims 77-79 recite program storage devices readable by
9 a machine and tangibly embodying a program of instructions capable of
10 performing the “if” conditional steps. Independent claims 80-82 recite
11 “means for” structure capable of performing the “if” conditional steps. As
12 the Examiner has not specifically set forth any structure in the combination
13 of Lewis, Ahmad, and Budow capable of performing the “if” conditional
14 steps, we do not sustain the rejections of these claims as well.

15 Due to their dependence on independent claims 58, 65, and 74, we
16 also do not sustain the rejections of dependent claims 59-64, 66-73, 75, and
17 76.

18 19 CONCLUSION OF LAW

20 On the record before us, Appellants have not shown that the Examiner
21 erred in rejecting claims 39-57.

22 On the record before us, Appellants have shown that the Examiner
23 erred in rejecting claims 58-82.

DECISION

The decision of the Examiner to reject claims 39-57 is affirmed.
The decision of the Examiner to reject claims 58-82 is reversed.
No time period for taking any subsequent action in connection with
this appeal may be extended under 37 C.F.R. § 1.136(a) (2007).

AFFIRMED-IN-PART

hh

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